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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,162	05/20/2002	Nikolai Grigorievich Lyapko	PAA-102-A	4990

7590

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EXAMINER

THALER, MICHAEL H

ART UNIT

PAPER NUMBER

3731

DATE MAILED: 04/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/031,162

Applicant(s)

LYAPKO, NIKOLAI  
GRIGORIEVICH

Examiner

Michael Thaler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 8-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 8-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no basis in the original disclosure for the limitation in claim 8, line 3 and claim 10, line 3 that each of the needles is T-shaped. A T-shape, by definition, requires the shape to be like the letter T. The top horizontal portion of the letter T is elongated and generally linear. The original disclosure is silent as to shape of head 4 when viewed in a direction along the longitudinal axis of the rod 2. For example, the head could be in the shape of a disc or a square and still be consistent with the remainder of the disclosure. If the head is in the shape of a disc or a square, the needle would not be T-shaped since there would be no elongated and generally linear member perpendicular to rod 2. There is no

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indication from the original disclosure that the head is in the shape of an elongated rod which is required for the needle to be T-shaped. Also, there is no basis in the original disclosure for the limitation in claim 8, lines 10-11 that the coat is made of steel. Although the original disclosure indicates that the base can be made of steel, it does not indicate that the coat can be made of steel.

Claims 8-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are confusing and inaccurate for the reasons set forth above.

Claims 8-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Choi (5,676,684) in view of Gabrusenok (SU 1264942) and Bajada (4,823,806). Choi discloses base member 15 and needles (col. 5, line 14) fixed therein, each of the needles comprising a rod, a sharpened portion and a head (the portion of the needle adjacent to base member 15). Choi fails to disclose each of the needles being T-shaped. However, Bajada teaches that tissue puncturing needles 40 should be T-shaped (as this term is best understood), with the top of the T being the head of the pin, apparently in order to obtain the advantage of securely attaching the needle 40 to the base member 26 since the

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head of the pin is securely held within 1) a pocket 37 of the base member 26 (col. 2, lines 44-47) or 2) a pocket of the base member 26 formed by the molding of the base member around the head of the pin (col. 5, lines 41-45). It would have been obvious to make each of the Choi needles T-shaped so that it too would have this advantage. Choi fails to disclose the needles as being partially coated with different materials. However, Gabrusenok teaches that acupuncture needles should be partially coated with different materials in order to obtain the advantage of creating electrochemical potentials (abstract). It would have been obvious to partially coat the Choi needles with different materials so that it too would have this advantage. As to claim 8, Choi fails to disclose the claimed materials for the needle bases and coats. However, applicant admits that these materials are old and well known in an applicator comprising a base member and needles (page 1, line 31 to page 2, line 2 of applicant's specification) which apparently has the advantages of making the needle strong and biologically inert. It would have been obvious to use these materials for the Choi device so that it too would have these advantages. As to claims 9, 12 and 13, the Choi needles, when modified by being partially coated with different materials as described above (in view of Gabrusenok), would be inherently arranged such that adjacent

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needles differ in materials exposed to an epidermis of a user of the applicator. For example, one needle near the center of base 15 of Choi (as seen in figure 1) could penetrate the skin relatively deeply such that both the needle extreme tip (corresponding to the material of element 1 of Gabrusenok) and the main portion of the coat (corresponding to the material of element 3 of Gabrusenok) would be exposed to the epidermis. However, an adjacent needle could penetrate the skin relatively less deeply (due to the curvature of the lower surface of base 15 of Choi) such that only the needle extreme tip (corresponding to the material of element 1 of Gabrusenok) would penetrate the skin and be exposed to the epidermis. Thus, the materials of the first needle which are exposed to the epidermis (i.e. two materials) differ from the material of the second needle which is exposed to the epidermis (i.e. only one material).

Applicant's arguments filed Feb. 7, 2006 have been fully considered but they are not persuasive for the reasons set forth above.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS

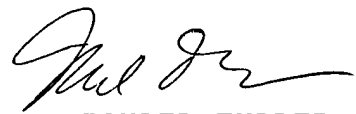
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of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (571)272-4704. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571)272-4963. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

mht  
3/30/06



MICHAEL THALER  
PRIMARY EXAMINER  
ART UNIT 3731